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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/689,911	10/11/2000	C. Alexander Turner JR.	LEX-0068-USA	9082
7590 10/16/2003 LANCE K. ISHIMOTO LEXICON GENETICS INCORPORATED 4000 RESEARCH FOREST DRIVE THE WOODLANDS, TX 77381			EXAMINER BUNNER, BRIDGET E	
			ART UNIT 1647	PAPER NUMBER

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	Application No. 09/689,911	Applicant(s) TURNER ET AL.	
	Examiner Bridget E. Bunner	Art Unit 1647	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 11 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 11 September 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-8.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

*Elizabeth C. Kemmerer*  
ELIZABETH KEMMERER  
PRIMARY EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because:

Claims 1-8 are rejected under 35 U.S.C. § 101 because the claimed invention is not supported by either a credible, specific and substantial asserted utility or a well established utility. Claims 1-8 are also rejected under 35 U.S.C. § 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention. The basis for these rejections is set forth at pg 2-8 of the previous Office Action (05 May 2003).

Applicant argues that the specification indicates that the presently claimed galanin family sequences are involved in a number of functions, including a role in inflammation and that this phenotype is confirmed in genetically engineered mice that lack the murine homolog of the presently claimed sequence (pg 1, lines 14-15; pg 2, lines 27-28). Applicant argues that the zymosan assay is a well known inflammation assay to those of skill in the art. Applicant's arguments have been fully considered but are not found to be persuasive. No substantial new arguments regarding this issue have been presented, and thus the rejections are maintained for reasons of record. It is noted that Applicant is encouraged to submit any pre- or post-filing date references or evidence in the form of a declaration under 37 C.F.R. 1.132 to support the specification. Applicant also asserts that nucleic acid sequences have the greatest specific utility in gene chip applications once the role of the sequence has been identified, as in the present case. Applicant's arguments have been fully considered but are not found to be persuasive. It is noted that the role of the polypeptide encoded by the claimed nucleic acid has not been established and no substantially new arguments regarding this issue have been presented, and thus the rejections are maintained for reasons of record. Additionally, Applicant argues that the present nucleotide has a specific utility in determining the genomic structure of the corresponding human chromosome. Applicant's arguments have been fully considered but are not found to be persuasive. No substantially new arguments regarding this issue have been presented, and thus the rejections are maintained for reasons of record. Finally, Applicant challenges the legality of the Patent Examination Utility Guidelines. No substantially new arguments regarding this issue have been presented, and thus the rejections are maintained for reasons of record.